

REMARKS

Favorable reconsideration is respectfully requested in view of the foregoing amendments and the following remarks.

I. CLAIM STATUS AND AMENDMENTS

Claims 1-12 were pending in this application when last examined and stand rejected.

Claim 1 is amended to incorporate the subject matter of claims 2, 3 and 6. Other minor editorial revisions have been made to the claims to better conform to US claim form and practice. Such revisions are non-substantive and not intended to narrow the scope of protection. Such revisions include: revising the beginning of the claims to recite "A" or "The"; revising the claim language throughout to provide proper antecedent basis for the recited claim terminology; and correcting a spelling error in claim 8.

No new matter has been added by the above claim amendments.

Claims 2-3, 6, and 13-14 have been canceled without prejudice or disclaimer thereto. Applicant reserves the right to file continuation or divisional application on any canceled subject matter.

Claims 1, 4-5, 7-12, and 15 are pending upon entry of this amendment.

The specification has been amended to include appropriate section headings to conform to US practice. No new matter has been added by this amendment.

Applicant notes the amended claims do not present any new issues for consideration and/or search as they incorporate subject matter already considered by the Office. Accordingly, if the next Office Action on the merits includes a new ground of rejection of one or more claims, the Action must be non-final.

Applicant is submitting the present amendment without prejudice to subsequent prosecution of the claims to some or all of the subject matter which might be disclaimed by virtue of this response (although none is believed to be), and explicitly reserves the right to pursue some or all such subject matter, in divisional or continuation applications.

Applicant thanks the Examiner for the careful examination of this case and respectfully requests reconsideration of the case, as amended. Below Applicant addresses the rejections in the Office Action and explains why the rejections are not applicable to the amended claims.

II. CLAIM OBJECTIONS

Claims 5 and 6 were objected to as being improper multiple dependent claims for the reasons noted in Item 1 on page 2 of the Office Action.

This rejection appears to be in error, because Applicant removed all multiple dependencies in the Preliminary

Amendment filed July 21, 2006. Accordingly, there are no multiple dependent claims remaining. For this reason, the rejection is unfounded and should be withdrawn.

III. INDEFINITENESS REJECTIONS

Claims 2-5 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite on the basis that the phrase "the adjacent regions" in line 2 of claim 2 lacks prior antecedent basis.

The present amendment overcomes this rejection by amending the claims so that each term has antecedent basis. The claims are thus clear, definite and have full antecedent basis. This rejection is believed to be overcome, and withdrawal thereof is respectfully requested.

IV. ANTICIPATION REJECTION

Claims 7-10 were rejected under 35 U.S.C. § 102(b) as anticipated by GAZAWAY (US 6,061,912) for the reasons set forth in item 6 on pages 2-3 of the Office Action.

This rejection is respectfully traversed.

It is well established that to anticipate a claim, a cited prior art reference must disclose or suggest each and every element of the claimed invention. Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987); and M.P.E.P., Eighth Ed., Rev. 6 (September 2007) at § 2131.

Applicant respectfully submits that the rejection fails, because GAZAWAY does not disclose or suggest each and every element of amended claim 7. In particular, amended claim 7 recites:

"A tool for the attachment of a hairpiece to a lock of hair using an adhesive curable by exposure to UV radiation, said tool comprising clamp means for clamping together in use, in abutting or overlapping fashion adjacent end regions of the lock of hair and the hairpiece, and means for directing UV radiation at said abutting or overlapping adjacent end regions."

As such, claim 7 is now directed to a tool for clamping a hairpiece comprising a clamp and means for directing UV radiation at a hairpiece.

By contrast, the tool described and illustrated in GAZAWAY shows a heatable cutting tool, for crimping, cutting and cauterizing multiple strands of fibers such as synthetic hair. Nowhere does GAZAWAY disclose or suggest a tool for the attachment of a hairpiece using UV radiation as in claim 7. Thus, it is clear that GAZAWAY fails to disclose this feature of amended claim 7. As such claim 7 is believed to be novel over GAZAWAY.

Further, GAZAWAY involves a cutting tool, not a hairpiece attaching tool and so the introduction of the UV means is not an obvious step to take, because using UV radiation (instead of heat) (for example IR radiation) would not generate significant heat, which in turn would mean the cutting and

cauterizing action proposed in that document would fail. GAZAWAY only discloses a cutting by means of heating. In this sense GAZAWAY teaches away from using UV radiation. For this additional reason, it would not have been obvious to modify the teaching in GAZAWAY to arrive at the invention of claim 7. Thus, claim 7 is considered to be novel and non-obvious over GAZAWAY.

Claims 8, 9 and 10 depend on claim 7 and are thus considered to be novel and non-obvious for the same reasons given above.

For these reasons, GAZAWAY cannot be said to disclose each and every element of amended claim 7. Thus, claim 7 and all claims dependent thereon are believed to be novel and non-obvious over GAZAWAY.

Therefore, withdrawal of the above 102(b) anticipation rejection is requested.

V. OBVIOUSNESS REJECTIONS

Claims 1-4 and 11 were rejected under 35 U.S.C. § 103(a) as being obvious over BARRINGTON (US 5,107,867) in view of MACK (US 4,602,143) for the reasons set forth in item 8 on pages 3-4 of the Office Action.

Claim 12 was rejected under 35 U.S.C. § 103(a) as being obvious over BARRINGTON (5,107,867) in view of GAZAWAY (US 6,061,912) for the reasons set forth in item 9 on pages 4-5 of the Office Action.

It is well established that to support a *prima facie* case of obviousness, the Office must provide a rationale showing that all the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions to yield predictable results. KSR International Co. v. Teleflex Inc., 550 U.S. ___, ___, 127 S. Ct. 1727, 82 U.S.P.Q.2d 1385, 1395 (2007); and M.P.E.P., Eighth Ed., Rev. 6 (September 2007) at § 2143.02.

Claim 1 has been amended so that the method claimed includes the step of bringing together a lock of hair and a hairpiece in contact with UV curable adhesive and exposing said adhesive to UV radiation. This method is not described in the cited prior art references.

In addition, Applicant has included a further feature in claim 1, namely that the adhesive is pre-applied to the hairpiece at an end region thereof (old claim 3). This feature is neither disclosed nor suggested by the cited references.

BARRINGTON shows a method of attaching hairpieces (22 Figure 4) using heat-shrink tubing (30). Again there is no suggestion of using UV light to cure an adhesive and the BARRINGTON technique seems to be proposing the opposite of the UV technique now proposed. In this sense, BARRINGTON teaches away from the claimed invention. For the BARRINGTON system to work, substantial heat is required to raise the temperature of the

materials used in order to shrink the tubing. Thus, BARRINGTON neither discloses nor suggests the use of UV radiation because sufficient heating is unlikely to take place if UV radiation is used.

Further, MACK shows curling tongs which employ electromagnetic IR radiation to heat hair (column 1, lines 44-48). There is no mention of attaching a hairpiece. Such heating tools are commonplace of course and, to our knowledge, generally use heat in one form or another.

In the method now claimed in claim 1, a UV curable adhesive is used and little or no heat is then required. Thus, it is not an obvious step to start at BARRINGTON and move to using UV, because it is more than a simple alternative to use UV instead of heat, even if the heat is provided by IR radiation as shown in MACK. The skilled person would need a different approach to find a suitable means of securing a hairpiece without significant heat. That approach is not obvious when starting with the prior art of BARRINGTON and MACK which deal exclusively with heating and do not mention UV radiation, let alone as a means for curing an adhesive.

For these reasons, it is clear that the cited references fail to disclose each and every element of claim 1 and they lack a rationale to combine and modify their teachings to arrive at the invention of claim 1.

Consequently, claim 1 is novel and non-obvious over BARRINGTON and MACK, separately or in combination because they both require that heat is used. Further, the use of heat is not as safe as using UV radiation when, for example, a dry hair extension is attached to the hair, and so the skilled person cannot start at BARRINGTON or MACK and arrive at the method now claimed in claim 1, without inventive thought.

Claims 2, 3 and 6 are incorporated into claim 1. Claims 4 and 5 are dependent on claim 1, and so Applicant believes these claims are novel and non-obvious for the same reasons given above.

The hairpiece of claim 11 is novel because it now includes a UV curable adhesive at an end region. There is no disclosure suggestion of those features in the prior art.

The kit of claim 12 is novel because its components are novel, and the claim has an inventive step for the reasons mentioned above.

For these reasons, neither BARRINGTON, nor MACK, nor GAZAWAY, nor any combination thereof discloses or suggests each and every element of the claims. Thus, the above 103 anticipation rejections are untenable and should be withdrawn.

In addition, Applicant wish to note that the invention is also novel and non-obvious over KING (WO 99/22694), which was cited but not relied upon. KING fails to disclose or suggest the feature of in claim 1, namely that the adhesive is pre-applied to

the hairpiece at an end region thereof. Instead, the method in KING relates to continual local delivery of adhesive to individual hairs, which is different therefrom.

V. CONCLUSION

Having addressed all the outstanding issues, the amendment is believed to be fully responsive. Thus, it is respectfully submitted that the application is in condition for allowance and notice to that effect is hereby requested. If the Examiner has any comments or proposals for expediting prosecution, please contact the undersigned at the number below.

The Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 25-0120 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17.

Respectfully submitted,

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